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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,258	11/29/2000	Vanessa Hsei	P1085R4-1AC1	4895

7590 09/30/2003

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EXAMINER
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ROARK, JESSICA H

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/726,258	<b>Applicant(s)</b> HSEI ET AL.	
	<b>Examiner</b> Jessica H. Roark	<b>Art Unit</b> 1644	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED            FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires            months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 July 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:           .

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s)            would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed:           .

Claim(s) objected to: 29.

Claim(s) rejected: 1, 25, 26, 28 and 31-36.

Claim(s) withdrawn from consideration: 20.

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PRIMARY EXAMINER  
*TECH CENTER 1600*  
*8/19/03*

8. ☐ The proposed drawing correction filed on            is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).           .
10. ☐ Other:

Continuation of 3. Applicant's reply has overcome the following rejection(s):

a) The previous rejection of claims 1, 25-26, 28-29 and 31-36 under 35 U.S.C. 112, second paragraph;

b) The Declaration under 37 CFR 1.132 filed 7/23/03 (originally filed in parent application 09/234182) is sufficient to overcome the rejection of claims 1, 25-26, 28-29 and 31-36 based upon either U.S. Pat. No. 6,133,426 (of record) or U.S. Pat. No. 6,025,158 (of record) by establishing that the invention disclosed but not claimed in the '426 and '158 patents was not "by another".

c) The previous provisional rejection of claims 1, 25-26, 28-29 and 31-36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 10-13, 15-19, 21, 24-26 and 28-34 of copending Application No. USSN 09/355,014.

It is noted that the terminal disclaimer filed on 7/23/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USSN 09/355,014 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant's arguments regarding the rejections of record in Paper No. 14 under 35 USC 103(a) appear to be essentially the same as those addressed in Paper No. 14. Applicant continues to argue that there was no motivation to combine the references because the glomerular cutoff was known to be about 70kD and that at best the teachings of the references create an "obvious to try" situation.

The Examiner's position is of record in Paper No. 14.

The proposed amendment to the claims does not alter the rejections of record under 35 USC 103(a); therefore, the following rejections are maintained:

a) The rejection of claims 1, 25, 31-33 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Zapata et al. (FASEB J. 1995, Abstract #1288, 9:A1479, IDS # 98) in view of Braxton (US Pat. No. 5,766,897, IDS #20);

b) The rejection of claims 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Zapata et al. (FASEB J. 1995, Abstract #1288, 9:A1479, IDS # 98) in view of Braxton (US Pat. No. 5,766,897, IDS #20) as applied to claims 1, 25, 31-33 and 36 above, and further in view of Doerschuk et al (U.S. Patent No. 5,702,946, IDS #18); and

c) the rejection of claims 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Zapata et al. (FASEB J. 1995, Abstract #1288, 9:A1479, IDS # 98) in view of Braxton (US Pat. No. 5,766,897, IDS #20) as applied to claims 1, 25, 31-33 and 36 above, and further in view of Griffiths et al (U.S. Patent No. 5,670,132, IDS #13).